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10/772,476	02/05/2004	Michael K. Brown	13210-140	4975

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BERESKIN AND PARR LLP/S.E.N.C.R.L., s.r.l.
40 KING STREET WEST
BOX 401
TORONTO, ON M5H 3Y2
CANADA

EXAMINER
LAI, MICHAEL C

ART UNIT	PAPER NUMBER
2457	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/772,476	BROWN ET AL.
	Examiner	**Art Unit**	
	MICHAEL C. LAI	2457	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>11 May 2010</u>.
2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1,7-14,23,29-36,45-55</u> is/are pending in the application.
    4a) Of the above claim(s) <u>47-55</u> is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) <u>1, 7-14, 23, 29-36, 45-46</u> is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☐ All   b) ☐ Some * c) ☐ None of:
      1. ☐ Certified copies of the priority documents have been received.
      2. ☐ Certified copies of the priority documents have been received in Application No. _____.
      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This office action is responsive to amendment filed on 5/11/2010.

Response to Amendment

The examiner has acknowledged the cancellation of claims 1, 7-14, 23, 29-36,

45-46, and the submission of new claims 47-55.

Response to Arguments

Applicant's arguments filed on 5/11/2010 have been fully considered but they are

not persuasive.

Newly submitted claims 47-55 are directed to an invention that is independent or

distinct from the invention originally claimed for the following reasons: They are now

directed to a method of encrypting text being viewed on a mobile device, the method

comprising the steps of providing, in a user interface of the mobile device, an

encryption option to encrypt the text; if the encryption option is selected, sending the

text to a processing server via a proxy server; and receiving the text in encrypted

form from the proxy server; wherein the proxy server is configured to format the text

into a hypertext markup language, send the formatted text to the processing server,

receive the text in encrypted form from the processing server, and send the text in

encrypted form to the mobile device; and wherein the processing server is

configured to receive text in the hypertext markup language as input, and output the

text in encrypted form. However, **original claims are directed to converting an**

initial message residing in a mobile computer device capable of wireless

access to a computer network into a processed message, the method

comprising: presenting a menu option to a user of the device for converting the initial message into the processed message, wherein program instructions for presenting the menu option originate in the mobile computer device; after the user selects the menu option to convert, wirelessly sending text in the initial message to at least one server on the computer network for converting the text in the initial message into the processed message; wherein the computer network comprises the Internet and the at least one server comprises a proxy and a processing server requiring input in hypertext markup language, said processing server configured to receive messages in the hypertext markup language and to process said messages in accordance with said menu option; wherein the text in the initial message is sent first to the proxy for conversion into a new format compatible with the processing server before sending the initial message in the new format to the processing server, and then to the processing server that further processes the initial message in accordance with said menu option, the new format being hypertext markup language; and the proxy converting the processed message into a device- formatted representation of the processed message, and the mobile computer device receiving the device-formatted representation of the processed message from the proxy. The Examiner's assertion that the new set of claims is distinct from the invention originally claimed.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for

prosecution on the merits. Accordingly, claims 47-55 are withdrawn from

consideration as being directed to a non-elected invention. See 37 CFR 1.142(b)

and MPEP § 821.03.

Claim Objections

1. Claim 1 is objected to because of the following informalities: In lines 14 and 19,

   the term "said menu option" should be "said selected menu option".

2. Claim 45 is objected to because of the following informalities: In lines 15 and 20,

   the term "said menu option" should be "said selected menu option".

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

   The specification shall contain a written description of the invention, and of the manner and process of
   making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to
   which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the
   best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 7-14, 23, 29-36, and 45-46 are rejected under 35 U.S.C. 112, first

   paragraph, as failing to comply with the enablement requirement. The claim(s)

   contains subject matter which was not described in the specification in such a

   way as to enable one skilled in the art to which it pertains, or with which it is most

   nearly connected, to make and/or use the invention.

       Claims 1, 23, and 45 recite the limitation of "…said processing server

   configured to receive messages in the hypertext markup language and to

   process said messages in accordance with said menu option…and then to the

   processing server that further processes the initial message in accordance with

   said menu option…" which was not described in the specification in such a way

as to enable one skilled in the art to which it pertains, or with which it is most

nearly connected, to make and/or use the invention. All dependent claims are

necessarily rejected as being dependent upon the rejected independent claims.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 7-14, 23, 29-36, and 45-46 are rejected under 35 U.S.C. 112, second

paragraph, as being indefinite for failing to particularly point out and distinctly

claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation of "sending text in the initial message to at least

one server on the computer network for converting the text in the initial message

into the processed message" in lines 8-9. It is unclear whether the text or the

initial message is being sent. It is also unclear whether the text or the initial

message is being converted into the processed message.

Claim 1 recites the limitation of "presenting a menu option to a user of the

device for converting the initial message into the processed message, wherein

program instructions for presenting the menu option originate in the mobile

computer device; after the user selects the menu option to convert..." in lines 4-

7. Claim 7 recites the limitation "The method of claim 1, wherein the menu option

is a translation option, an encryption option, a spell check option or a thesaurus

option". It is unclear whether only one option, or all options is/are being

presented to the user. It is also unclear whether the user selects the only one

option being presented or one from options being presented.

Claim 1 recites the limitation of "the proxy converting the processed message

into a device- formatted representation of the processed message..." in lines 20-

23. It is unclear how and when the proxy has possession of the processed

message.

Claims 23 and 45 have similar limitations as claim 1. They are rejected for

the same reasons as for claim 1.

All dependent claims are necessarily rejected as being dependent upon the

rejected independent claims.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art
are such that the subject matter as a whole would have been obvious at the time the invention was made to
a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be
negatived by the manner in which the invention was made.

8. Claims 1, 7-14, 23, 29-36, and 45-46 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Kasai et al. (US 7,216,072 B2, hereinafter Kasai).

Regarding claim 1, Kasai discloses a method of converting an initial message

residing in a mobile computer device capable of wireless access [FIG. 17 and

col. 11, lines 22-25, handheld terminal or cellular phone] to a computer network

into a processed message, the method comprising:

presenting a menu option to a user of the device for converting the initial

message into the processed message, wherein program instructions for

presenting the menu option originate in the mobile computer device [FIG. 3, col. 5, lines 63-66; FIG. 17 and col. 21, lines 22-26];

after the user selects the menu option to convert, wirelessly sending text in the initial message to at least one server on the computer network for converting the text in the initial message into the processed message in accordance with said menu option [col. 21, lines 33-49, "Further, the translated mail server 32 sends the text information to the translation server 33 and requests the server 33 to translate it"];

wherein the computer network comprises the Internet [FIG. 17, Translation System on Internet] and the at least one server comprises a proxy and a processing server requiring input in hypertext markup language [col. 9, lines 21-32, HTML data input; FIG. 17, col. 21, lines 42-49. Note that the translated mail server (32) and the translation server (33) forming part of the server system (1) in Kasai's reference are equivalent to the proxy (22) and the processing server (24) in the claim];

wherein the text in the initial message is sent first to the proxy for conversion from a text format into a new format compatible with the processing server before sending the initial message in the new format to the processing server, and then to the processing server that further processes the initial message in accordance with said menu option, [FIG. 17, col. 21, lines 42-49; Note that the proxy server (32) actually does some sort of format

conversion for the translation server (33) when extracting text from an email];

and

the proxy converting the processed message into a device- formatted

representation of the processed message, and the mobile computer device

receiving the device-formatted_representation of the processed message from

the proxy [col. 6, lines 6-9, the WWW server uses HTML implying the proxy

converts the message into a device-formatted message before sending it to

the mobile device; col. 21, lines 54-56].

Kasai discloses all limitations of claim 1, except the new format being

hypertext markup language. However, it is known to a person skilled in the art

that emails can be sent in several formats including HTML. And because of the

high versatility of HTML, a person skilled in the art would certainly consider this

language to solve the problem of translation of emails using different formats in

Kasai's fourth embodiment. Thus, it would have been obvious to a person with

ordinary skill in the art at the time the invention was made to convert from a text

format into HTML before sending the message to the processing server as a

choice of options, thereby solving the problem of translation of emails using

different formats.

Regarding claim 7, Kasai discloses the method of claim 1, wherein the menu

option is a translation option, an encryption option, a spell check option or a

thesaurus option [Kasai, FIG. 3 and col. 7, lines 17-21, translation option].

Regarding claim 8, Kasai discloses the method of claim 1, wherein the text in the initial message comprises text displayed on the mobile computer device in a first language [Kasai, FIG. 3].

Regarding claim 9, Kasai discloses the method of claim 8, wherein the text forms part of an email [Kasai, FIG. 9 and col. 14, lines 19-34].

Regarding claim 10, Kasai discloses the method of claim 8, wherein the text is in a Web page [Kasai, FIG. 1, browser on the device and the WWW server uses HTML].

Regarding claim 11, Kasai discloses the method of claim 8, wherein the menu option is a translation option, such that when the translation option is selected, a pop-up is displayed prompting a user of the mobile computer device to choose at least one translation characteristic option [Kasai, FIG. 3 and col. 6-7, lines 59-26].

Regarding claim 12, Kasai discloses the method of claim 11, wherein the pop-up prompts the user to identify the first language [Kasai, FIG. 3 and col. 6-7, lines 59-26].

Regarding claim 13, Kasai discloses the method of claim 11, wherein the pop-up prompts the user to choose a second language into which the text is to be translated [Kasai, FIG. 3 and col. 7, lines 22-26].

Regarding claim 14, Kasai discloses the method of claim 1, but silent about further comprising, before the step of presenting, automatically checking to determine whether the initial message corresponds to text in a language that is

not native to a user of the mobile computer device. Official Notice is taken for

checking the initial message to see if the text is in a language that is not native to

the user, as this is essential for determining if a translation is needed. It would

have been obvious to a person with ordinary skill in the art at the time the

invention was made to do so for the purpose of avoiding unnecessary operation

by determining if a translation is needed before presenting the menu to the user,

thereby providing a more efficient translation system.

Claims 23, 29-36 are of the same scope as claims 1, 7-14. They are rejected

for the same reason as for claims 1, 7-14 respectively.

Claim 45 is of the same scope as claim 1. It is rejected for the same reason

as for claim 1.

Regarding claim 46, Kasai discloses the computer-readable medium of claim

45, wherein the initial message is in a first language, and the processed

message is in a translated language [Kasai, col. 6, lines 2-5, request/response

messages].

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of

time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire

THREE MONTHS from the mailing date of this action. In the event a first reply is

filed within TWO MONTHS of the mailing date of this final action and the advisory

action is not mailed until after the end of the THREE-MONTH shortened statutory

period, then the shortened statutory period will expire on the date the advisory

action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

calculated from the mailing date of the advisory action. In no event, however, will

the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

9. The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. Applicant is reminded that in amending in response to a

rejection of claims, the patentable novelty must be clearly shown in view of the

state of the art disclosed by the references cited and the objection made.

Applicant must show how the amendments avoid such references and

objections. See 37 CFR 1.111(c).

10. Hokao, US 6,907,256 B2, has taught a mobile terminal with an automatic

translation function.

11. Hayashi Hiroto, JP 2001 251429 A, has taught a mobile voice translation system.

12. Fish, WO 02/23389 A1, has taught systems and methods for translating

information.

13. Majumdar et al., US 2003/0120813 A1, has taught an apparatus and method for

generating compressed SIP messages from full sized SIP messages and vice

versa in order to decrease call set up time in an IP based communication system.

Examiner's Note: Examiner has cited particular columns and line numbers in

the references applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL C. LAI whose telephone number is (571)270-3236. The examiner can normally be reached on M-F 8:30 - 5:00 EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through

Private PAIR only. For more information about the PAIR system, see http://pair-

direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free). If you would like assistance from a USPTO Customer Service

Representative or access to the automated information system, call 800-786-

9199 (IN USA OR CANADA) or 571-272-1000.

Michael C. Lai
07JUL2010

/YVES DALENCOURT/
Primary Examiner, Art Unit 2457